



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,019	10/01/2003	Venkatachalam Eswarakrishnan	1796A1	9521

7590 01/08/2008
PPG INDUSTRIES, INC.
Intellectual Property Department
One PPG Place
Pittsburgh, PA 15272

EXAMINER

MAYEKAR, KISHOR

ART UNIT	PAPER NUMBER
----------	--------------

1795

MAIL DATE	DELIVERY MODE
-----------	---------------

01/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/677,019	Applicant(s) ESWARAKRISHNAN ET AL.	
	Examiner Kishor Mayekar	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-19,21-47,51 and 52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-19,21-47,51 and 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 November 2007 has been entered.

Claim Rejections - 35 USC § 112

2. Claims 1, 23 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the recitation "an aqueous medium" in the claim body is confusing as to its similar recitation in the claim preamble.

In claim 23, the recitation "an aqueous medium" in step (1) is confusing as to its similar recitation in the claim preamble and in step (5).

In claim 32, the recitation "an aqueous medium" in the claim body is confusing as to its similar recitation earlier claimed.

Claim Rejections - 35 USC § 102 and 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 2, 6-10, 16-19, 23-27, 29-38 and 44-47 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Eswarakrishnan et al. (US 5,630,922). Eswarakrishnan's invention is directed an electrodepositable coating composition containing diorganotin dicarboxylates. Eswarakrishnan discloses that the diorganotin dicarboxylate (or dialkyltin dicarboxylate) may be prepared by reacting the one or more different types of carboxylic compound, where at least one is the long chain carboxylic acid, with a diorganotin compound such as dialkyltin oxide (paragraphs 3 and 4 of col.7). In Example II-I, Eswarakrishnan discloses the diorganotin dicarboxylate is dioctyltin dioleate. Eswarakrishnan also discloses that the electrodepositable coating composition comprises the recited resinous phase (abstract and paragraph 4 of col. 5); the diorganotin dicarboxylate may be added to the final reaction mixture of the main vehicle, i.e., the active hydrogen-containing resin (paragraph 2 of col. 8 and Example B); and the electrodepositable coating composition is cured from 120° C to 190° C (paragraph 4 of col. 10) or at 171° C (or 341° F). It has been held that the disclosure in the prior art of any value within the claimed range is an anticipation of that

range. And a prima facie case of obviousness exists in the case where the claimed range overlaps range disclosed by the prior art, *In re Wertheim* 191 USPQ 90.

As to the subject matter of claims 19, 30 and 47, Eswarakrishnan discloses in the abstract that the diorganotin dicarboxylate is present in an amount of at least 0.01 percent by weight of tin based on weight of total solids of the electrodepositable composition.

As to the subject matter of claims 25 and 26, Eswarakrishnan's electrodepositable composition inherently possesses it since it comprises the recited diorganotin dicarboxylate.

5. Claims 11-15, 28 and 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eswarakrishnan '922 in view of Nishiguchi et al. (US 6,761,973 B2), a reference cited in the last Office action. The difference between Eswarakrishnan as applied above and the instant claims is the recited blocking agent. Nishiguchi teaches the limitation in a cationic resin composition (see abstract). The subject matter as whole would have been within the level of ordinary skill in the art at the time the invention was made to have modified Eswarakrishnan's teachings as shown by Nishiguchi because the selection of any of known equivalent blocking agents would be within the level of ordinary skill in the art.

6. Claims 21, 22, 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eswarakrishnan '922 in view of Nishiguchi et al. (US 6,265,079 B1. The difference between Eswarakrishnan as applied above and the instant claims is the recited coating composition. Nishiguchi teaches the limitation in a cationic resin composition (see abstract and paragraph 3 of col. 5). The subject matter as whole would have been within the level of ordinary skill in the art at the time the invention was made to have modified Eswarakrishnan's teachings as shown by Nishiguchi because this would result in a coating with anticorrositivity without the use of lead compound.

Response to Arguments

7. Applicant's arguments filed 8 November 2007 have been fully considered but they are not persuasive because of the new grounds of rejection as set forth in the paragraphs above.

Conclusion

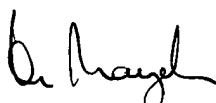
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

Application/Control Number:
10/677,019
Art Unit: 1795

Page 6

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Kishor Mayekar
Primary Examiner
Art Unit 1795